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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER	
SMITH, E	
ART UNIT	**PAPER NUMBER**
1505	7

DATE MAILED: 12/26/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) 30-40 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-29 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☑ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☑ None of the CERTIFIED copies of the priority documents have been

☑ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☑ Notice of Reference Cited, PTO-892

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

★ U.S. GPO: 1996-409-290/40029

15. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-28, drawn to catalysts, classified in Class 502, subclass 126.

II. Claims 30-40, drawn to compounds, classified in Class 568, subclass 579+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as a solvent.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with James C. Lydon on September 24, 1996 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-29. Affirmation of this election must be made by applicant in responding to this

Office action. Claims 30-40 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Claim 29 will be examined with Group I.

16. Claims 1-3, 8-17 and 22-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of the phrase "5-n . . . or 3" makes the scope of the claim unclear since it is not clear how many carbon atoms are in this embodiment.

17. Claims 1-6, 8-20 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albizzati et al. (492), Albizzati et al. (213) and Barbe et al. all together or all in view of Denko.

Albizzati et al. (213) generically teaches the use of the claimed ethers as external electron donors in the claimed titanium component catalyst (column 2, lines 3-8 and lines 54-60) while Albizzati et al. (492) and Barbe et al. teach the use of some saturated cyclic analogs of the claimed diethers, Albizzati et al. (213) (column 4, lines 17-20) e.g., 1,1-dimethoxymethylcyclopentane and Barbe et al. (column 3, lines 7-11, lines 21-23). In view of these teachings, it would be obvious to use the 1,3-diethers of the Albizzati et al.

references or Barbe et al. reference wherein the cyclic group that forms part of the 2-position carbon atom is unsaturated. Thus, cyclopolyenic 1,3-diethers such as 1,1-bis(methoxymethyl)cyclopentadiene would be obvious from its cyclopentane analog.

This use is further strengthened by Denko who teaches acetal electron donors wherein the carbon atom attached to the two oxygen atoms is part of a cyclic unsaturated ring.

18. Claims 1-6, 8-20 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kioka in view of Barbe et al., Albizzati et al. (492) and Denko.

It would be obvious to use the claimed diethers in the process of Kioka because (1) the reference generically includes them, (2) Albizzati et al. (492) and Barbe et al. disclose some cyclic saturated analogs and (3) one of ordinary skill in the art would believe that the claimed diethers would be suitable in the process of the primary reference.

Denko is applied as in paragraph 17 above.

EJSmith:cdc
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December 18, 1996

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ART UNIT